

Amendments to the Drawings:

The attached sheet of drawings includes changes to Figures 12 and 14.
This sheet replaces the original sheets including Figures 12 and 14.

Attachment: Replacement Sheets

REMARKS

This Response is submitted in reply to the Final Office Action dated December 13, 2005, and in accordance with the telephone interview courteously granted by the Examiner on February 23, 2006. Claims 1, 4, 5, 6, 12, 21, 36 and 38 have been amended. New Claims 63 to 68 have been added. The specification and Figures 12 and 14 have been amended for consistency and to correct typographical errors noted therein. No new matter was added by these amendments or new claims.

An RCE is submitted herewith. A check in the amount of \$2090.00 is submitted herewith to cover the cost of the new claims and the RCE. Please charge Deposit Account No. 02-1818 for any insufficiency of payment or credit any overpayment.

Applicants thank the Examiner for courteously granting the telephone interview on February 23, 2006. The following remarks constitute Applicants' written statement as to the substance of the interview.

The Office Action rejected Claims 1 to 20 under 35 U.S.C. § 103(a) as being unpatentable over DeMar et al. (U.S. Patent No. 6,270,410; hereafter "DeMar") in view of Hughes, IV (U.S. Patent No. 6,120,025; hereafter "Hughes"). As discussed in the telephone interview, the Examiner inadvertently omitted Cordell (U.S. Patent Application Publication 2004/0140617) from the statement of rejection. Accordingly, Applicant' believe that the present Office Action intended to reject Claims 1 to 20 under 35 U.S.C. § 103(a) as being unpatentable over DeMar in view of Hughes and Cordell.

Based on this omission and the following analysis, Applicants respectfully submit that the present Office Action was prematurely made Final. The rejection of Claims 1 to 20 under 35 U.S.C. § 103(a) as being unpatentable over DeMar in view of Hughes and Cordell, as intended by the Office Action, constitutes a new ground of rejection. The Office Action stated that Applicants' amendment necessitated the new ground of rejection and was made Final. Applicants respectfully disagree that Applicants' amendments from the Response filed on September 6, 2005 necessitated the new ground of rejection because

independent Claim 12 and dependent Claims 13 to 20 were not amended in the September 2005 Response. Since a new ground of rejection for Claims 12 to 20 was intended for and entered in the present Office Action, Applicants respectfully submit that the finality of the present Office Action is premature. Accordingly, Applicants respectfully request that in the event that this application is not in condition for allowance after consideration of the above amendments and the remarks herein, the finality of the present Office Action under MPEP § 706.07(a) be removed or withdrawn.

Applicants will now address the merits of the new ground of rejection. DeMar discloses a gaming system with a remote control which may be hard wired to a slot machine. Hughes discloses a grip for a controller of a video game machine or video computer system. Cordell discloses a gaming system with a retractable remote controller. Accordingly, the combination of DeMar, Hughes and Cordell provides a gaming system with a retractable remote control which may be hard wired to a gaming machine and secured to a grip.

Amended independent Claim 1 recites a gaming device that comprises, among other elements, a switch connected extendably and retractably to the cabinet. The switch has a relatively rigid housing that defines a recessed portion therein. The switch also has a relatively elastomeric cover disposed in the recessed portion of the housing. The switch is operable with the processor to control a function of the game. Unlike the gaming device in Claim 1, the combination of DeMar, Hughes and Cordell does not teach, disclose, or suggest a switch having a relatively rigid housing that defines a recessed portion therein and a relatively elastomeric cover disposed in the recessed portion of the housing. Accordingly, Applicants respectfully submit that amended independent Claim 1 is patentably distinguished over the combination of DeMar, Hughes and Cordell and in condition for allowance.

Dependent Claims 2 to 11 depend from independent Claim 1 and are also allowable for the reasons given above with respect to independent Claim 1, and because of additional features recited in those claims. Specifically, dependent Claim 10 recites an elastomeric cover that is molded to a rigid housing after the

housing has cured and dependent Claim 11 recites an elastomeric cover and a housing that are simultaneously cured. The Office Action equated molding to placing the grip on the controller (page 6). Placing the grip on the controller as taught by Hughes differs from the molding process described in Applicants' specification. Hughes, alone or in combination with DeMar and Cordell, does not teach or suggest the elements of dependent Claims 10 and 11. Accordingly, dependent Claims 10 and 11 are patentably distinguished from the combination of DeMar, Hughes and Cordell and in condition for allowance.

The Office Action indicated that Hughes teaches materials co-molded together to provide a non-slip grip for the user, which enables more effective use of the controller (page 6). Applicants respectfully disagree. Hughes does not disclose, teach or suggest molding the grip and the controller, or more specifically, co-molding the grip and the controller as described in Applicants' specification. Hughes merely discloses a grip that is permanently or removably secured to a controller. The grip has an interior surface that is secured to an exterior surface of the controller in position with respect to a portion of the cord. The grip is positioned around the cord and is secured to the controller so that the cord extends through the grip. Hughes does not teach or suggest a grip or controller that are formed via molding or co-molding or formed from molded or co-molded components or materials. Neither DeMar nor Cordell remedies this deficiency of Hughes.

Amended independent Claim 12 recites a gaming device that comprises, among other elements, an extendable switch connected to the cabinet and in communication with the processor through a connecting cord. The extendable switch has a first co-molded material adhered to multiple surfaces of a second co-molded material. Unlike the gaming device of Claim 12, the combination of DeMar, Hughes and Cordell does not teach, disclose or suggest an extendable switch having a first co-molded material adhered to multiple surfaces of a second co-molded material in position with respect to a portion of the cord. Rather, the combination of DeMar, Hughes and Cordell relates generally to a remote control or controller having a cord that extends through a grip. The grip has an interior

surface that is secured to an exterior surface of the remote control or controller in position with respect to a portion of the cord. A remote control or controller having a cord that extends through a grip and that is secured to the grip cannot be characterized as an extendable switch having a first co-molded material adhered to multiple surfaces of a second co-molded material in position with respect to a portion of the cord. Moreover, for the reasons discussed above, the combination of DeMar, Hughes and Cordell does not teach co-molded materials as recited in Claim 12. Applicants' Figure 5 illustrates an extendable switch having a first co-molded material adhered to multiple surfaces of a second co-molded material in position with respect to a portion of the cord which the combination of DeMar, Hughes and Cordell does not teach, disclose or suggest. Accordingly, Applicants respectfully submit that independent Claim 12 is patentably distinguished over the combination of DeMar, Hughes and Cordell and in condition for allowance.

Dependent Claims 13 to 20 depend from independent Claim 12 and are also allowable for the reasons given above with respect to independent Claim 12, and because of additional features recited in those claims. Specifically, dependent Claim 16 recites a second material including an elastomeric cover that is molded to a rigid housing after a first material has cured. Hughes merely discloses a grip that is permanently or removably secured to a video game controller. Hughes, alone or in combination with DeMar and Cordell, does not teach or suggest the elements of dependent Claim 16. Accordingly, dependent Claim 16 is patentably distinguished from the combination of DeMar, Hughes and Cordell and in condition for allowance.

The Office Action's identified motivation to combine DeMar, Cordell and Hughes appears to reside in the possibility for one skilled in the art to combine DeMar, Cordell and Hughes. Relating to Cordell, page 5 of the Office Action states that "[b]y having a retractable remote controller, one of ordinary skill in the art would allow customers to remotely control the gaming machine from a comfortable distance away fro[m] the gaming machine while standing or reclining, or otherwise sitting, in a chair, stool, etc." Relating to Hughes, Page 6

of the Office Action states that “even if ‘the first and second materials are co-molded’ results in different structural characteristics of the end product than other molding methods, it still would have been *prima facie* obvious at the time the invention was made to use ‘co-molded’ materials in DeMar et al. since Hughes, IV teaches that having materials co-molded together provides a non-slip grip for the user, enabling more effective use of the controller.” This rational is improper to establish a *prima facie* case of obviousness according to MPEP §§ 2142 and 2143. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Neither DeMar, Hughes nor Cordell, whether analyzed individually or in combination, provides any motivation or suggestion to combine a gaming machine with a retractable remote controller which may be hard wired to a gaming machine as taught by DeMar and Cordell with a grip for a controller of a video game or video computer system as taught by Hughes.

Regardless of whether one skilled in the art would have been motivated to combine DeMar, Hughes and Cordell as proposed in the Office Action, the resulting gaming device would not disclose, teach or suggest all of the elements recited in independent Claims 1 and 12. As discussed above, the resulting combination does not teach or suggest a gaming device that comprises a switch having a relatively rigid housing that defines a recessed portion therein and a relatively elastomeric cover disposed in the recessed portion of the housing, as recited in independent Claim 1. Similarly, the resulting combination does not teach or suggest a gaming device that comprises an extendable switch having a first co-molded material adhered to multiple surfaces of a second co-molded material in position with respect to a portion of the cord, as recited in independent Claim 12. Accordingly, Applicants respectfully submit that independent Claims 1 and 12 and respective dependent Claims 2 to 11 and 13 to 20 are patentably distinguished over the combination of DeMar, Hughes and Cordell and in condition for allowance.

The Office Action rejected Claims 21 and 25-40 under 35 U.S.C. § 103(a) as being unpatentable over Cordell in view of Hollowed (U.S. Patent No. 6,293,485).

As generally discussed above, Cordell teaches a gaming system with a retractable remote controller. More specifically, Cordell teaches a retractable remote controller tethered to a gaming machine so that the retractable remote controller is movable from a retracted position (not shown) to an extended position (Figs. 1, 3 and 4). Movement of the remote controller is controlled through a braking device (Fig. 2 and paragraphs [0030], [0031] and [0032]). In one embodiment, Cordell teaches a game machine housing that includes buttons to control activate features of the game machine and a remote controller that is received in a receiving slot of the housing when moved into the retracted position (Fig. 3 and paragraph [0042]). While in the receiving slot, the remote controller is inoperable by a player. In another embodiment, the remote controller is received in a securing receptacle on a front portion of the gaming machine housing (Fig. 4 and paragraphs [0048] and [0049]). While in the securing receptacle, the remote controller is operable by the player and constitutes buttons to activate various features of the gaming machine. Hollowed teaches a cord storage assembly having a ratchet mechanism that cooperates with a cord to allow the cord to be moved from a retracted position to extended positions. Accordingly, the combination of Cordell and Hollowed provides a gaming device having a retractable remote controller that is movable from a retractable position to extended positions via a cord storage assembly and ratchet mechanism.

Amended independent Claim 21 recites a gaming device that comprises, among other elements, a cabinet including at least one button operable by a person and a switch connected extendably and retractably to the cabinet via a cord, a spring and a ratchet. The spring causes the switch and cord to retract into a retracted position. The ratchet operates to lock the switch and cord in at least one extended position. The switch and the at least one button are independently operable by the person when the switch and the cord are moved into the retracted position. In Cordell, the remote controller is inoperable by a

player when retracted into the game machine housing in one embodiment (Fig. 3). In another embodiment of Cordell, the remote controller includes activation buttons for the gaming machine that are operable by a player when the remote controller is retracted into the game machine housing (Fig. 4). Unlike the gaming device of Claim 21, the combination of Cordell and Hollowed does not teach, disclose or suggest a cabinet including at least one button operable by a person and a switch connected extendably and retractably to the cabinet via a cord, a spring and a ratchet, wherein the switch and the at least one button are independently operable by the person when the switch and cord are moved into a retracted position. Accordingly, Applicants respectfully submit that independent Claim 21 is patentably distinguished over the combination of Cordell and Hughes and in condition for allowance.

Dependent Claims 25 to 35 depend from independent Claim 21 and are also allowable for the reasons given above with respect to independent Claim 21, and because of additional features recited in those claims.

Amended independent Claim 36 recites a gaming device that comprises, among other elements, a cabinet including at least one operational button and a switch connected extendably and retractably to a cabinet via a cord and a mechanism. The mechanism is operable to enable the cord to be pulled by a person to multiple predetermined extended positions defined by the mechanism and then released by the person, wherein the cord in each of the extended positions will thereafter recoil automatically to a fully retracted position. The switch is positioned adjacent to the at least one operational button and is operable by a person when the switch and the cord are moved into the fully retracted position. In one embodiment of Cordell, the remote controller is inaccessible when retracted into the game machine housing (Fig. 3). In another embodiment of Cordell, the remote controller includes activation buttons for the gaming machine when retracted into the game machine housing (Fig. 4). Unlike the gaming device in Claim 36, the combination of Cordell and Hollowed does not teach, disclose or suggest a cabinet including at least one button and a switch connected extendably and retractably to a cabinet via a cord and a

mechanism, wherein when the switch and the cord are moved into the fully retracted position, the switch is (i) positioned adjacent to the at least one operational button and (ii) operable by a person. Accordingly, Applicants respectfully submit that amended independent Claim 36 is patentably distinguished over Cordell and Hollowed and in condition for allowance.

Dependent Claims 37 to 40 depend from independent Claim 36 and are also allowable for the reasons given above with respect to independent Claim 36, and because of additional features recited in those claims.

The Office Action rejected Claims 22 to 24 under 35 U.S.C. § 103(a) as being unpatentable over Cordell in view of Hughes and further in view of Hollowed.

Hughes does not remedy the deficiencies of the proposed combination of Cordell and Hollowed discussed above with respect to independent Claim 21. Hughes discloses a grip for a controller of a video game machine or video computer system. Like independent Claim 21, dependent Claims 22 to 24 recite a cabinet including at least one button operable by a person and a switch connected extendably and retractably to the cabinet via a cord, a spring and a ratchet, wherein the switch and the at least one button are independently operable by the person when the switch and cord are moved into a retracted position. The proposed combination of Cordell, Hughes and Hollowed does not teach or suggest this combination of elements. Accordingly, Applicants respectfully submit that dependent Claims 22 to 24 are patentably distinguished over the combination of Cordell, Hollowed and Hughes and in condition for allowance.

New independent claims 63 to 68 are presented for the Examiner's consideration. Like independent claims 12, 21 and 36, new independent claims 63 to 68 are patentably distinguished over DeMar, Cordell, Hughes and Hollowed whether analyzed alone or in combination. Accordingly, new claims 63 to 68 are in condition for allowance. New claims 63 to 68 are at least supported by Figs. 2A, 2B and 5 through 8 of Applicants Specification.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Reply, Applicants respectfully request that the Examiner contact the undersigned.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY: 

Adam H. Masia
Reg. No. 35,602
Customer No. 29159

Dated: March 13, 2006